

## REMARKS

The Final Office Action dated August 19, 2008 contained a final rejection of claims 1-11 and 24-34. The Applicants have amended claims 1 and 24. Claims 1-11 and 24-34 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-6, 8, 24-29 and 31 under 35 U.S.C. § 102(b) as allegedly being anticipated by Roztocil (U.S. Patent Publication No. 2001/0044868). The Office Action rejected claims 7, 9, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Roztocil in view of Kemp (U.S. Patent Publication No. 2001/0078160). The Office Action rejected claims 10, 11, 33 and 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roztocil and Kemp.

The Applicant respectfully traverses these rejections and submits that the combined cited references does not disclose, teach or suggest all of the elements of the Applicant's newly amended independent claims.

For example, the Applicant's newly amended independent claims now include **automatically checking for common errors** associated during a prepress stage by **automatically pre-flighting** the document to be printed, **automatically revising incorrect printing instructions** and **automatically adding missing** printing instructions and **automatically** providing a **remote proofing function** for a customer of the document to be printed and **automatically tracking** the printing of the document by **continuously monitoring** and updating a status of the document to be printed. Support for these amendments can be found throughout the specification, and in particular, in paragraphs [0025] - [0038] of the Applicant's specification as originally filed.

In contrast, with regard to the anticipation rejection, the Roztocil reference simply discloses allowing a customer to submit a job during job origination by either physically delivering to the print shop one or more documents in hard copy or electronic form or by transmitting the one or more documents to the print shop via the Internet (see paragraph [0022] of Roztocil). Although Roztocil discloses workflow 200 that includes a preflight stage 204 that is performed using a workflow management software program that executes on a job preparation workstation 116 **at the print shop (emphasis added; see paragraph [0036] of Roztocil)**, the program in Roztocil

merely allows operators **at the print shop** to obtain data about the various output devices **122 of the print shop**, including their availability and capabilities (see paragraph [0045] of Rostocil).

In addition, Rostocil does not perform the follow combination of features of the Applicant's independent claims: automatically checking for common errors, automatically pre-flighting the document to be printed, automatically revising incorrect printing instructions and automatically adding missing printing instructions, automatically providing a remote proofing function and automatically tracking the printing of the document by continuously monitoring it.

Consequently, the Rostocil reference is clearly missing the newly added features of the independent claims as described above. Therefore, since Rostocil does not disclose all of the features of the Applicant's independent claims, Rostocil cannot anticipate claims 1-6, 8, 24-29 and 31, and hence, the anticipation rejection should be withdrawn.

Regarding the obviousness rejection, Kemp merely adds a system and method for printing over the Internet, which includes a client, a service provider, and a portal (see paragraph [0035] of Kemp). As such, when the references are combined, they simply disclose that **all aspects of the production work flow** are performed **at the print shop** using its network, using workflow management software to simply obtain data on devices in the print shop (see paragraphs [0023-0033] of Rostocil) and that the client is required to submit queries to the portal when locating a suitable service provider by using job tickets (see paragraphs [0043], [0053] and [0056] of Kemp).

In contrast to the Applicant's independent claims, at the **designer location and not the print shop**, common errors associated during a prepress stage are checked by automatically pre-flighting the document to be printed, **automatically revising incorrect printing instructions** and automatically adding missing printing instructions, automatically providing a remote proofing function for a customer of the document to be printed and automatically tracking the printing of the document by continuously monitoring and updating a status of the document to be printed at the **designer location and not the print shop**.

Moreover, the Examiner is reminded that the references **should not** be considered together with the benefit of hindsight. Improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used, or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's

invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

**Even if the references in question seem relatively similar** "...the opportunity to judge by hindsight is particularly tempting. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention from all of the Applicant's independent claims. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

Therefore, because the combined cited references are missing at least one feature of the independent claims and because hindsight cannot be used, the Applicant submits that a prima facie case of obviousness does not exist. As a result, the independent claims are patentable over the combined references. As such, withdrawal of the obviousness rejections of the claims is respectfully requested.

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). As such, withdrawal of the obviousness rejection of the claims is respectfully requested.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly requests the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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